

## **REMARKS/ARGUMENTS**

Amendments are made to the Specification to correct errors and clarify the Specification. No new matter is added by any of these amendments to the Specification.

Claims 1, 3-7, 9-13, 15-16 and 18-24 are pending in the present application. Claims 4, 6, 19, and 20 are canceled. Claims 2, 8, 14, and 17 were previously canceled in the Response to Office Action dated May 18, 2006. Claims 1, 7, and 13 are amended. Reconsideration of the claims is respectfully requested.

### **I. Telephonic Interview with Primary Examiner Poinvil on May 29, 2007**

Applicants thank Primary Examiner Frantzy Poinvil for the courtesy extended to Applicants' representative during the May 29, 2007 telephonic interview. During the teleconference, the Examiner and Applicant's representative discussed possible independent claim amendments to further distinguish the present invention from the cited reference. No agreement was reached. The substance of the interview, as well as additional reasons that the claims are not anticipated, is summarized in the remarks of Sections III, which follows below.

### **II. Pertinence of Each Reference Must be Clearly Explained and Each Rejected Claim Specified**

"In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified." 37 C.F.R. §1.104(c)(2). In this case, the Examiner has neither "clearly explained" the pertinence of the cited reference nor "specified" each rejected claim.

In rejecting claims 1, 3-7, 9-13, 15-16, and 18-24, the Examiner states:

PR NewsWire discloses that BuildPoint.com launches a Web-based Business to Business Solution system and method for facilitating a request for proposal (RFP) in an electronic market place. In the system and method of BuildPoint.com, there includes functions of:

Posting the RFP in an electronic marketplace;

Communicating a portion of the RFP to at least one secondary marketplace participant from a plurality of primary and secondary marketplace participants, wherein the primary marketplace participants are general contractors and the secondary market participants are subcontractors and wherein the subcontractors submit proposals on particular components of the RFP in which they specialize;

Providing access to the RFP to the plurality of primary and secondary marketplace participants, wherein access to the RFP is utilized by the at least one

secondary marketplace participant from the plurality of primary and secondary marketplace participants to generate a proposal for the portion of the RFP; and posting the proposal in the electronic marketplace.

Applicant is directed to the entire two-page article.

The proposal is also restricted to specific parties.

As bids or proposals are being submitted, modified versions of the RFP is being generated. The marketplace is a public marketplace such as the Internet and is also a private marketplace of secondary and primary participants.

The at least one secondary marketplace participant collaborates with at least one of the plurality of primary and secondary marketplace participants to generate the proposal for the portion of the RFP and access to the RFP by the plurality of primary and secondary marketplace participants enables the plurality of primary and secondary marketplace participants to propose various solutions enabling alternative work breakdowns for at least a portion of the RFP.

See the article. [Emphasis added].

Final Office Action dated April 9, 2007, item 2, pages 2 and 3.

As is evident from the immediately preceding passage above, the Examiner does not specify each rejected claim as required by 37 C.F.R. §1.104(c)(2). Furthermore, the Examiner does not clearly explain the pertinence of the cited reference as applied to the claims or designate as nearly as practicable the particular parts relied on. The Examiner merely cites the entire prior art reference. Therefore, Applicants respectfully submit that the Examiner's rejection of claims 1, 3-7, 9-13, 15-16, and 18-24 is inadequate according to 37 C.F.R. §1.104(c)(2) and places an undue burden on Applicants to adequately respond to the Final Office Action dated April 9, 2007.

### **III. 35 U.S.C. § 102, Anticipation, Claims 1, 3-7, 9-13, 15-16, and 18-24**

The Examiner rejects claims 1, 3-7, 9-13, 15-16, and 18-24 under 35 U.S.C. § 102 as allegedly being anticipated by an article by *PR NewsWire* related to BuildPoint.com ("PR NewsWire"). This rejection is respectfully traversed. Dependent claims 4, 6, 19, and 20 are canceled by this Response to Office Action. Therefore, the rejection of claims 4, 6, 19, and 20 under 35 U.S.C. § 102 is now moot. However, the recited features of canceled claims 4, 6, 19, and 20 are incorporated into the independent claims.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). All limitations of the claimed invention must be considered when determining patentability. *In re Lowry*, 32 F.3d 1579, 1582, 32 U.S.P.Q.2d 1031, 1034 (Fed. Cir. 1994). Anticipation focuses on whether a claim reads on the product or process a prior art reference discloses, not on what the reference broadly teaches. *Kalman v. Kimberly-Clark*

*Corp.*, 713 F.2d 760, 218 U.S.P.Q. 781 (Fed. Cir. 1983). In this case, each and every feature of the presently claimed invention is not identically shown in the cited reference as arranged in the claims.

Amended independent claim 1 of the present invention, which is representative of amended independent claims 7 and 13 with regard to similarly recited subject matter, reads as follows:

1. A method for facilitating a request for proposal (RFP) in an electronic marketplace, the method comprising the computer implemented steps of:
  - posting the RFP in an electronic marketplace, wherein the electronic marketplace is a private marketplace;
  - communicating a portion of the RFP to at least one secondary marketplace participant from a plurality of primary and secondary marketplace participants, wherein the primary marketplace participants are general contractors and the secondary marketplace participants are subcontractors, and wherein the subcontractors submit proposals on particular components of the RFP in which they specialize, and wherein the at least one secondary marketplace participant collaborates with at least a second one of the plurality of primary and secondary marketplace participants to generate the proposal for the portion of the RFP;
  - providing access to the RFP to the plurality of primary and secondary marketplace participants, wherein access to the RFP is utilized by the at least one secondary marketplace participant from the plurality of primary and secondary marketplace participants to generate a proposal for the portion of the RFP, and wherein access to the RFP by the plurality of primary and secondary marketplace participants enables the plurality of primary and secondary marketplace participants to propose various solutions enabling alternative work breakdowns for at least a portion of the RFP;
  - posting the proposal in the electronic marketplace; and
  - posting a modified version of the RFP in the electronic marketplace, wherein the modified version of the RFP is based upon proposals submitted by the primary and secondary marketplace participants.

In rejecting the claims, the Examiner states:

PR NewsWire discloses that BuildPoint.com launches a Web-based Business to Business Solution system and method for facilitating a request for proposal (RFP) in an electronic market place. In the system and method of BuildPoint.com, there includes functions of:

- Posting the RFP in an electronic marketplace;
  - Communicating a portion of the RFP to at least one secondary marketplace participant from a plurality of primary and secondary marketplace participants, wherein the primary marketplace participants are general contractors and the secondary marketplace participants are subcontractors and wherein the subcontractors submit proposals on particular components of the RFP in which they specialize;
  - Providing access to the RFP to the plurality of primary and secondary marketplace participants, wherein access to the RFP is utilized by the at least one secondary marketplace participant from the plurality of primary and secondary marketplace participants to generate a proposal for the portion of the RFP;
  - and posting the proposal in the electronic marketplace.
- Applicant is directed to the entire two-page article.  
The proposal is also restricted to specific parties.  
As bids or proposals are being submitted, modified versions of the RFP is being

generated. The marketplace is a public marketplace such as the Internet and is also a private marketplace of secondary and primary participants.

The at least one secondary marketplace participant collaborates with at least one of the plurality of primary and secondary marketplace participants to generate the proposal for the portion of the RFP and access to the RFP by the plurality of primary and secondary marketplace participants enables the plurality of primary and secondary marketplace participants to propose various solutions enabling alternative work breakdowns for at least a portion of the RFP.

See the article.

Final Office Action dated April 9, 2007, item 2, pages 2 and 3.

PR NewsWire teaches a system for an “interactive business-to-business Web commerce solution” for the construction materials industry. PR Newswire, page 1, lines 15-16. “Contractors can publicly post project information for bidding to the entire BuildPoint.com community and create a centralized location where partners can download, view and print all project information required to formulate a bid, including project plans and specifications.” PR Newswire, page 1, line 67 (last line) – page 2, line 3. “The BuildPoint.com environment will include transaction-ready content as well as commerce services such as transaction processing, trade financing, bid management and directory services.” PR Newswire, page 2, lines 35-37. In other words, PR Newswire teaches a centralized Website (www.BuildPoint.com) where project owners can publicly post construction projects in order to receive competitive bids online by downstream contractors for the posted projects. The centralized Website provides transaction processing, trade financing, bid management, and directory services.

In contrast, as amended, claim 1 recites “posting the RFP in an electronic marketplace, wherein the electronic marketplace is a private marketplace.” The Examiner states that “[t]he marketplace is a public marketplace such as the Internet and is also a private marketplace of secondary and primary participants.” Final Office Action dated April 9, 2007, page 3, lines 9 and 10. However, even though PR NewsWire may teach an electronic marketplace, PR NewsWire only teaches a public marketplace (i.e., the Internet) using a centralized Website (i.e., www.BuildPoint.com). PR NewsWire makes no reference to “a private marketplace” as recited in amended claim 1. Therefore, PR NewsWire does not identically teach this recited claim 1 feature.

In addition, claim 1 recites “communicating a portion of the RFP to at least one secondary marketplace participant from a plurality of primary and secondary marketplace participants.” [Emphasis added]. In other words, only a portion of the RFP is directly communicated to at least one subcontractor by the general contractor or another subcontractor in the method recited in claim 1. PR Newswire instead teaches that an entire project is publicly communicated to the entire BuildPoint.com community on the centralized Website. Therefore, PR Newswire does not identically teach this recited claim 1 feature either.

Further, amended claim 1 recites that “the at least one secondary marketplace participant collaborates with at least a second one of the plurality of primary and secondary marketplace participants to generate the proposal for the portion of the RFP.” [Emphasis added]. PR NewsWire makes no reference to at least one subcontractor collaborating with a general contractor or another subcontractor to generate the proposal for that portion of the publicly posted project information. PR NewsWire instead teaches that “[c]ontractors can publicly post project information for bidding to the entire BuildPoint.com community and create a centralized location where partners can download, view and print all project information required to formulate a bid, including project plans and specifications.” [Emphasis added]. PR Newswire, page 1, line 67 (last line) – page 2, line 3. Therefore, PR NewsWire does not identically teach this recited claim 1 feature either.

Furthermore, amended claim 1 recites that “access to the RFP by the plurality of primary and secondary marketplace participants enables the plurality of primary and secondary marketplace participants to propose various solutions enabling alternative work breakdowns for at least a portion of the RFP.” PR NewsWire makes no reference to general contractors and subcontractors, by having access to the publicly posted project information on the centralized Website, are able to propose various solutions enabling alternative work breakdowns for at least a portion of the publicly posted project information. In contrast, PR NewsWire only teaches that “[t]he BuildPoint.com environment will include transaction-ready content as well as commerce services such as transaction processing, trade financing, bid management and directory services.” PR Newswire, page 2, lines 35-37. Therefore, PR NewsWire does not identically teach this recited claim 1 feature either.

Moreover, amended claim 1 recites “posting a modified version of the RFP in the electronic marketplace, wherein the modified version of the RFP is based upon proposals submitted by the primary and secondary marketplace participants.” PR NewsWire makes no reference to posting a modified version of the publicly posted project information in the centralized Website. Instead, PR NewsWire only teaches that “[c]ontractors can publicly post project information for bidding to the entire BuildPoint.com community.” PR Newswire, page 1, line 67 (last line) – page 2, line 1. Therefore, PR NewsWire does not identically teach this recited claim 1 feature either.

As a result, PR NewsWire does not identically teach each and every element recited in amended claim 1 of the present invention. Accordingly, the rejection of independent claims 1, 7, and 13 as being anticipated by PR NewsWire has been overcome. In view of the arguments above, amended independent claims 1, 7, and 13 are in condition for allowance. Thus, entry of these amendments as placing the application in condition for allowance is believed to be proper and is respectfully requested. Claims 3, 5, 9-12, 15, 16, 18, and 21-24 are dependent claims depending on independent claims 1, 7, and 13.

Consequently, claims 3, 5, 9-12, 15, 16, 18, and 21-24 also are allowable, at least by virtue of their dependence on allowable claims.

Accordingly, the rejection of claims 1, 3-5, 9-13, 15, 16, 18, and 21-24 as allegedly being anticipated by PR NewsWire has been overcome.

#### **IV. Conclusion**

It is respectfully urged that the subject application is patentable over the cited prior art reference and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

DATE: June 22, 2007

Respectfully submitted,

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